

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re application of Dufour et al. : ANTIROTATION TOOL HOLDER  
Group Art Unit 3722 : AND CUTTING INSERT  
Serial No. 10/553,277 : Confirmation No. 6625  
Filed 6 July 2006 :  
Examiner Willmon Fridie, Jr. :

**REMARKS FOR PRE-APPEAL BRIEF CONFERENCE**

Sir:

In response to the 14 August 2007 final Office Action in the above application, Applicants request a Pre-Appeal Brief Conference in accordance with guidelines in the "New Pre-Appeal Brief Conference Pilot Program" announcement appearing in the 12 July 2005 *Official Gazette*. In accordance with those guidelines, arguments for the conference are presented herein. Submitted concurrently herewith are: a Pre-Appeal Brief Request for Review (form PTO/SB/33); a Notice of Appeal; the fee under 37 CFR § 41.20(b)(1); and a Petition for Extension of Time and associated fee. Any deficiency or overpayment may be charged or credited, respectively, to Deposit Account No. 11-1110. The issues addressed herein are ripe for appeal in accordance with 37 CFR § 41.31(a)(1), and the claims having been subject to at least two rejections.

**Arguments**

Applicants filed a "Response to Final Office Action", including claim amendments, on 15 October 2007 ("October 15 Response"). October 14 fell on a Sunday. Therefore, the October 15 Response was filed within two months of the final Office Action. Under MPEP § 706.07(f)(I), the Examiner was required to consider whether the October 15 Response placed the Application in condition for allowance. The Examiner issued a 30 October 2007 Advisory Action stating that the October 15 Response did not place the Application in condition for allowance, but the Examiner did not provide any comments responsive to the arguments and declaratory evidence submitted in the October 15 Response. In addition, for reasons set out in the

"Continuation of 3. NOTE" portion of the Advisory Action, the Examiner refused to enter the claim amendments Applicants included in the October 15 Response. In a 20 November 2007 phone conference between the Examiner and the undersigned in which the Examiner's refusal to enter the claim amendments was discussed, the Examiner indicated that he was inclined to enter the claim amendments in the October 15 Response, but requested that Applicants file a request for reconsideration setting forth Applicants' arguments. Applicants subsequently filed a 30 November 2007 "Request for Reconsideration of Entry of Amendments" ("Request for Reconsideration") addressing the Examiner's stated reasons for refusing to enter the claim amendments included in the October 15 Response. The undersigned left two voice-mail messages with the Examiner (in late December and early January) requesting a decision on the Request for Reconsideration, but the Examiner has not ruled on the Request. Therefore, Applicants assume that claims 32-63 currently are pending in the Application in the amended forms that Applicants submitted with their 16 May 2007 "Response to Office Action" ("May 16 Response").

In the present pre-appeal proceeding, Applicants request: (1) entry of the claim amendments in the October 15 Response; (2) withdrawal of the Examiner's claim rejections under 35 USC § 102(b) based on Satran et al., U.S. Patent No. 6,164,878 ("Satran"); (3) withdrawal of the Examiner's claim rejections under 35 USC § 103(a) based on Satran; and (4) allowance of the Application.

Regarding the Examiner's refusal to enter the claim amendments in the October 15 Response, the Request for Reconsideration explains why the Examiner's stated reasons for refusing to enter the claims are unsupported and the amendments should have been entered. Specifically, for the reasons discussed in the Request for Reconsideration, the proposed claim amendments clearly are in harmony with the descriptive matter in the specification and necessarily are confined to the disclosure of the Application. In addition, the proposed claim amendments clearly do not raise a question under MPEP § 2172.01. Therefore, the Examiner's refusal to enter the claim amendments in the October 15 Response should be reversed. On entry of the claim

amendments in the October 15 Response, the Application will include claims 32, 33, 35-41, 44-47, and 61-63.

Regarding the Examiner's § 102(b) rejections, as discussed on pages 6-7 of the October 15 Response, the Examiner did not properly support his assertion that Satran inherently discloses a tool holder made using tangential milling. As discussed, the Examiner's apparent conclusion that the tool holder *possibly* was made using tangential milling is insufficient to support an inherency rejection as per MPEP § 2112(IV).

Moreover, even assuming for sake of argument that the Examiner's assertion of anticipation by inherency is supported, Applicants presented arguments and declaratory evidence in the May 16 and October 15 Responses clearly showing that Satran: (1) does not disclose a tool holder that includes features recited in claims 32 and 33; and (2) does not disclose a tool holder that could have been made by the method recited in claims 32 and 33. In particular, as discussed on pages 6-9 of the October 15 Response, and as unequivocally confirmed by the uncontroverted Declaration of Dr. X. Daniel Fang submitted therewith, the cutting insert pocket (52) depicted in Figures 4 and 5 of Satran could not have been formed by the method including tangential milling recited in the claims. On pages 9-12 of the October 15 Response, and in the May 16 Response, Applicants also clearly establish that certain limitations recited by or incorporated in claims 32 and 33 are not present in the tool holder described in Satran.

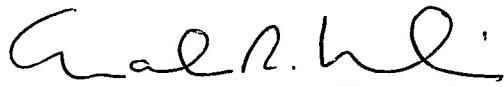
The Examiner did not provide any meaningful indication in the Advisory Action that he considered Applicants' arguments related to claims 32 and 33, or that he considered and gave proper evidentiary weight to the Fang Declaration, as is required under MPEP § 706.07(f)(l). However, even if the Examiner did consider and give proper weight to Applicants' arguments and the declaratory evidence, the Examiner's refusal to withdraw the § 102(b) rejection of claims 32 and 33 over Satran should be withdrawn for at least the reason that Applicants established that Satran does not disclose a tool holder that could have been formed by the method recited in claims 32 and 33. Simply, Applicants cannot identify any basis for the Examiner's refusal to withdraw the § 102(b) rejections of claims 32 and 33.

Regarding the Examiner's § 103(a) rejections, Applicants note that on entry of the claim amendments included in the October 15 Response, each of claims 33, 35-41, 44-47, and 61-63 will ultimately depend from claim 32. Given that the Examiner's rejection of claim 32 is improper and should be withdrawn, it follows that the Examiner's § 103(a) rejections also should be withdrawn. Withdrawing the §§ 102(b) and 103(a) rejections should result in allowance of the Application.

Conclusion

Applicants respectfully submit that the claim amendments submitted in the October 15 Response should be entered, that all claim rejections should be withdrawn, and that the Application should be allowed.

Respectfully submitted,



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